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08/133,986 10/12/93 JOHNSON

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J 7709-18US03

EXAMINER

BAYERL, R

ART UNIT

PAPER NUMBER

7

2301

DATE MAILED:

12/10/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12 Oct 1993 8 Dec 1993 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), - days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449. 2 sheets
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☒ Examiner Interview Summary Record
(2 sheets)

Part II SUMMARY OF ACTION

1. ☒ Claims 45-59 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-44, 60 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 45, 47-55, 59 are rejected.

5. ☒ Claims 46, 56-58 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Serial Number: 08/133,986
Art Unit: 2301

-2-

1. In response to observations made by the Examiner, Applicant has authorized an Examiner's Amendment to the record, which has been entered. Such Authorization was given during a telephone interview with Mr. Vietzke, Reg. No. 36,708, Applicant's representative of record, on 29 November 1993.

The Amendment is as follows:

Claim 56, line 7--"the" has been changed to "a";

Claim 60 has been cancelled.

2. Applicant asserts in the remarks accompanying the 12 October 1993 preliminary amendment that the present Application is intended "to prosecute method claims for the present invention". During a 29 November 1993 telephone interview, the Examiner pointed out that the close correspondence between the present "method" claims and the allowed apparatus claims in parent Application 07/959,525 (to become US Patent #5,283,865) presented the issue of obviousness-type double patenting. To avoid rejection on this ground, Applicant agreed to a Terminal Disclaimer referring to the commonly-assigned parent Application. The Terminal Disclaimer was received via facsimile on 8 December 1993 and entered on 9 December 1993.

3. Applicant has also filed an information disclosure statement (received 2 Dec 1993) containing references cited in the parent Application, since this is a continuation under 37 CFR 1.60. However, the last two references cited on sheet 2 of 2

bear incomplete listings and have therefore not been considered--
what is the publication source of the two drawings?

4. The following is a quotation of 35 U.S.C. § 103 which
forms the basis for all obviousness rejections set forth in this
Office Action:

A Patent may not be obtained though the invention is not
identically disclosed or described as set forth in Section
102 of this Title, if the differences between the subject
matter sought to be patented and the prior art are such that
the subject matter as a whole would have been obvious at the
time the invention was made to a person having ordinary
skill in the art to which said subject matter pertains.
Patentability shall not be negated by the manner in which
the invention was made.

Subject matter developed by another person, which qualifies
as prior art only under subsection (f) or (g) of Section 102
of this Title, shall not preclude patentability under this
Section where the subject matter and the claimed invention
were, at the time the invention was made, owned by the same
person or subject to an obligation of assignment to the same
person.

5. Claims 45, 47 - 55, 59 are rejected under 35 USC 103 as
being unpatentable over Read Me First, CWC, Inc., June 1988
(cited on sheet 2 of the attached form PTO 1449).

As per claim 45's "computerized method of selling parts
for particular equipment specified by a customer", Read Me First
outlines the operation of the CASS Parts Program, which can be
used by a parts salesperson in preparing professional proposals
(page 3). The customer being served by this program can provide
the salesperson with information such as Equipment owned (page 3)
so as to help select the parts which a customer needs (page 14).
It would have been obvious to a person having ordinary skill in

Serial Number: 08/133,986
Art Unit: 2301

-4-

the art at the time of Applicant's invention that the claimed "method of selling parts" involve "receiving information identifying a customer's parts requirements for the equipment" as per "equipment application information" regarding "an identification of the equipment with which one or more parts are to be used" because the CASS Parts Program as described is intended to tailor a computerized sales presentation to individual customer needs, such as the "application" to which parts represented by "electronically specifying information identifying a plurality of parts and specifications" are to be put. The CASS Parts Program contains a Cross Reference Module to find the parts (page 13), as in "gathering parts-related information for one or more parts...which meets the customer's requirements", such requirements possibly including "equipment application information", and it permits the user to write the proposal, as in "compiling the parts-related information into a proposal".

Claim 47's "receiving feature information" for "electronically associating" reads upon any identification of parts to be interactively retrieved for a customer in the reference. Suppose, after identifying "the equipment with which one or more parts are to be used" (claim 45), the customer then has a particular parts category for that equipment which must be investigated. An input of this parts category would be a "feature" specification. This argument is also applicable to

claim 48's "selecting a type of the equipment" and "a manufacturer", all further obvious specifications a CASS parts program user could provide because they narrow the field of parts within program storage according to the particular needs and interests of the customer.

Claim 49's "printed version of the proposal" is fully taught at page 7 of the Read Me First publication, where under printer requirements (page 7), [t]he printer puts the information generated by the program on paper for the customer to consider.

Claim 50's "proposal" including "specifications corresponding to the one or more parts" is a limitation met by any parts description in the CASS parts program proposal generation, since such a description will necessarily specify parts in some manner. Such proposal specification can also include prices in the sales effort (page 12), as in claim 51's "price information", claim 52's "graphical information" (graphic pictures to help you present the features and benefits of your product, page 14), claim 53's "textual information" (text, also page 14), and "an animated demonstration" as in claim 54 (a product "slide" presentation, page 14, which suggests a sequence of images which show a time-progressive operation of a part under consideration). Since such graphic pictures and a "slide" presentation relate to equipment parts, their pictorial content would be capable of "graphically illustrating...construction features" (claim 55).

Claim 59's use of "a portable personal computer" is directly shown in the portable system discussion at page 6 of the reference.

6. Claims 46, 56 - 58 are objected to for depending upon rejected claim 45, but would be submitted for Issue if placed in independent claim form.

Claim 46 has, in addition to acquiring "equipment application information", obtaining "at least a portion of a manufacturer's part number" in order to access parts information. The Read Me First manual presents the options of finding a part according to user needs and directly specifying part number as alternative (not joint) procedures. At page 18, the new method is intended for particular customer proposal generation, such as a proposal meeting the needs of Equipment owned. In contrast, the none method is used when you do not need to collect customer information, such as to use Cross Reference to locate a part, as by its parts number, which would be readily familiar to the salesperson but not necessarily to the customer. This alternate set of entry methods is also characteristic of the later Read Me First manual cited (with a February 1989 date). Thus, the Examiner deems that to specify both "equipment application" and "at least a portion of a manufacturer's part number" is not fairly taught nor suggested by the prior art made of record.

Also distinguishing over the art of record, such as the June 1988 Read Me First publication, is claim 56's "receiving

Serial Number: 08/133,986
Art Unit: 2301

-7-

information identifying a first feature and a second feature of a particular part" to generate "information describing the first and second features" and "information describing how the first and second features affect performance of the particular part". While plural parts features (such as parts category and manufacturer) might be used to narrow the search for a customer's needs in the CASS parts program, such features would not enter into a description of parts performance, which is based more on the particular merits of an individual part bearing a different type of feature description, such as part construction, materials, etc.

7. During a 9 December 1993 telephone conversation with Mr. Vietzke, Applicant's representative, Applicant indicated that a showing under 37 CFR 1.131 could be made that the 1988 Read Me First publication was actually unavailable to the public until after 12 November 1988, and therefore less than or equal to one year before the effective filing date (13 November 1989) of the present Application. The Examiner indicated that this 37 CFR 1.60 continuation was on the Special docket and needed to be examined before Applicant would have time to prepare and submit such a 37 CFR 1.131 declaration. The evidence currently present in the case, therefore, is that the reference relied upon in the above 35 USC 103 rejection was published in June 1988, not 13 November 1988 or later, and it thus qualifies as prior art under 35 USC 102(b) and cannot be sworn behind without convincing facts

Serial Number: 08/133,986
Art Unit: 2301

-8-

before the Examiner that "a printed publication" or "public use" or "sale" embodying its subject matter did not occur until after 12 November 1988. Applicant must further show that the true date of invention antedates this alleged later publication date for the 1988 Read Me First reference.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Raymond J. Bayerl, whose telephone number is (703) 305-9789. Any inquiry of a general nature or relating to the status of this Application should be directed to the Group receptionist, whose telephone number is (703) 305-9600.



RAYMOND J. BAYERL
PATENT EXAMINER
ART UNIT 2301

9 Dec 1993